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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,697	05/29/2001	Takehiro Yoshida	35.C15377	5737
5514	7590	06/27/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SAFAIPOUR, HOUSHANG	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/865,697	YOSHIDA, TAKEHIRO
	<b>Examiner</b>	<b>Art Unit</b>
	Houshang Safaipour	2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 April 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

<ol style="list-style-type: none"> <li>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)        Paper No(s)/Mail Date _____.</li> </ol>	<ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413)        Paper No(s)/Mail Date _____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: _____.</li> </ol>
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## **DETAILED ACTION**

Applicant's amendment filed on April 4, 2005 has been entered and made of record.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended claims make reference to “**transmitting the image data according to both-side transmitting protocol**” and “**transmitting the image data according to one-side transmitting protocol**”. The attorney (Mr. Krause), during a telephone conversation, referred to page 20 of the specification for support for these protocols. In examiner's opinion, the referenced section of the specification, discloses the determination of single or double sided capabilities and not two distinct transmitting protocols as claimed. Therefore, based on these arguments, examiner maintains his rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Yutaka Kido (JP 11-17877).

Regarding claim 1, Yutaka Kido discloses a facsimile apparatus for reading image data of a both-side original and transmitting it, comprising: reading means for reading images on both sides of the original; discriminating means for discriminating whether effective image data is included on both sides of the original read by said reading means or not; and control means for executing a both-side transmission of the image data read from the both sides of the original if it is determined by said discriminating means that at least one sheet of original in which the effective image data is included on the both sides exists, and executing a one-side transmission of the image data read from a front side of the original in the other cases (pages 7-13).

Regarding claim 2, Yutaka Kido discloses an apparatus according to claim 1, wherein even if at least one sheet of original in which the effective image data is included on the both sides exists, when a receiver on a partner side does not have a both-side transmission mode, only the sides including the effective image data are transmitted in order from the front side and a reverse side by using a one-side transmitting procedure (pages 7-13).

Regarding claim 3, Yutaka Kido discloses, an apparatus according to claim 1, further comprising operating means for designating a compulsory front side reading mode for reading only the image on the front side of the original, wherein when said compulsory front side reading mode is selected by said operating means, even if at least one sheet of original in which the

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effective image data is included on the both sides exists, only the front side of the original is read and the read image data is transmitted in a one-side mode (pages 7-13).

Regarding claim 4, Yutaka Kido discloses a control method of a facsimile apparatus for reading image data of a both-side original and transmitting it, comprising: a discriminating step of discriminating whether effective image data is included on both sides of the read original or not; and a control step of executing a both-side transmission of the image data read from the both sides of the original if it is determined by said discriminating step that at least one sheet of original in which the effective image data is included on the both sides exists, and executing a one-side transmission of the image data read from a front side of the original in the other cases (pages 7-13).

Regarding claim 5, Yutaka Kido discloses a method according to claim 4, wherein even if at least one sheet of original in which the effective image data is included on the both sides exists, when a receiver on a partner side does not have a both-side transmission mode, only the sides including the effective image data are transmitted in order from the front side and a reverse side by using a one-side transmitting procedure (pages 7-13).

Regarding claim 6, Yutaka Kido discloses a method according to claim 4, wherein when a compulsory front side reading mode for reading only a image on the front side of the original is selected, even if at least one sheet of original in which the effective image data is included on the both sides exists, only the front side of the original is read and the read image data is transmitted in a one-side mode (pages 7-13).

Regarding claims 7-9, arguments analogous to those presented for claims 1-4 are applicable to claims 7-9.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipour whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles, Sr. can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Houshang Safaipour  
Patent Examiner  
Art Unit 2622  
June 21, 2005

  
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